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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/807,376

03/24/2004

Bjorn Ljungberg

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05/09/2006

DRINKER BIDDLE & REATH (DC)

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WASHINGTON, DC 20005-1209

EXAMINER

TURNER, ARCHENE A

ART UNIT

PAPER NUMBER

1775

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/807,376

Applicant(s)

LJUNGBERG, BJORN

Examiner

Archene Turner

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-17 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Applicant's election with traverse of Group II in the reply filed on 2/8/06 is acknowledged. The traversal is on the ground(s) that there is no serious burden to the examiner. This is not found persuasive because since the search for group I is not required for Group II, and the examiner is not an expert in the process technology the examiner does not agree that there would not be a serious burden if searched together.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-4, 18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 2-6-06.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 5, 7-17, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Ljungberg et al (5,683,640).

The rejection is maintained. Applicant's arguments filed 2/8/06 have been fully considered but they are not persuasive. The applicant argues that the claimed columnar

structure is not necessarily inherent but has not provided any factual evidence to convince the examiner of this position and the rejection stands.

5. Claims 5, 7, 11,15,16,19 are rejected under 35 U.S.C. 102(b) as being anticipated by Ljungberg et al (5,487,625) .

The rejection is maintained. Applicant's arguments filed 2/8/06 have been fully considered but they are not persuasive. The applicant argues that the claimed columnar structure is not necessarily inherent but has not provided any factual evidence to convince the examiner of this position, especially in light of the applicants disclosure on page 3, line 2, and thus the rejection stands..

6. Claims 5,6,11,15,16,19 are rejected under 35 U.S.C. 102(b) as being anticipated by Ljungberg et al (5,766,782) or Van Den Berg et al (5,516,588) or Goedicke et al (5,698,314) .

The rejection is maintained. Applicant's arguments filed 2/8/06 have been fully considered but they are not persuasive. The applicant argues that the claimed columnar structure is not necessarily inherent but has not provided any factual evidence to convince the examiner of this position and the rejection stands..

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6,20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ljungberg et al (5,766,782 or 5,487,625)

Ljungberg et al discloses the invention as claimed except for the claimed component of the substrate. It would have been obvious to one of ordinary skill in the art to provide the disclosed coating on Ljungberg et al on the claimed substrate as these substrates are known to be used in the cutting tool art and known to need protection by coatings.

9. Claims 6,20,21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ljungberg et al (5,863,640)

Ljungberg et al discloses the invention as claimed except for the claimed component of the substrate. It would have been obvious to one of ordinary skill in the art to provide the disclosed coating on Ljungberg et al on the claimed substrate as these substrates are known to be used in the cutting tool art and known to need protection by coatings.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Archene Turner whose new telephone number is (571) 272-1545. The examiner can normally be reached on Monday, Wednesday through Friday from 10:30 am. to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Please remember to include on the fax, the art unit 1775, serial number and Examiner's name.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'A. A. Turner', with a long horizontal flourish extending to the right.

A. A. Turner
Primary Examiner
Group 1700

aat